

### **Remarks/Arguments**

Claims 1 to 8, 21 to 25, 31 and 32 are pending. Claims 1, 3 and 21 have been amended and new Claims 3 and 34 have added.

The Office Action stated: that Claims 1 to 8, 21 to 25, 31 and 32 are currently pending in the instant application; and that applicants cancelled Claims 9 to 20 and 26 to 30 and added new Claims 31 and 32 in an amendment filed on February 13, 2007.

The Office Action stated that the instant application is a 371 of PCT/EP03/07411, filed on July 9, 2003, which claims benefit to foreign application EP 02015229.4, filed on July 9, 2002.

The Office Action stated: that the information disclosure statements (IDS) submitted on August 3, 2005 and August 22, 2005 are in partial compliance with the provisions of 37 CFR 1.97; and that, accordingly, the information disclosure statement has been partially considered by the Examiner.

The Office Action stated that applicants' election with traverse of Group I in the reply filed on February 13, 2007 is acknowledged.

The Office Action stated that the traversal is on the ground that: (1) Groups I to IV form a single general inventive concept and should be included together in the restriction requirement.

The Office Action stated that all of the applicants' arguments have been considered but have not been found persuasive.

The Office Action stated: that it is pointed out that the restriction requirement is made under 35 U.S.C. 121. 35 U.S.C. 121 gives the Commissioner (Director) the authority to restrict applications to several claimed inventions when those inventions are found to be independent and distinct; and that the Examiner has indicated that more than one independent and distinct invention is claimed in this application and has restricted the claimed subject matter accordingly.

The Office Action stated: that applicants' argue that Groups I to IV form a single general inventive concept and should be included together in the restriction requirement; that, in independent Claim 1, R<sup>1</sup> and R<sup>2</sup> are each defined as a Markush group; that in the Examiner's definition of each Groups I to IV, R<sup>2</sup> is stated to be as defined in Claim 1; that further, in each of Groups I to IV, R<sup>1</sup> is C<sub>1-8</sub>-alkyl, phenyl, furanyl and thienyl, respectively; that all of these species or subgroup provide the same utility in the invention and share a substantial structural feature essential to that utility; that the definition of R<sup>1</sup> in Groups I to IV, in essence, form a Markush group that has utility; that the definition of R<sup>1</sup> in Groups I to IV, in essence, form a Markush group that has unity of invention; that, however, the Examiner wants to point out that the independent Claim 1 is drawn to a process for the preparation of a compound of formula I; that since the compound of formula I is the final product, the special technical feature is related to the final product of the claimed process; that the special technical feature is defined by the Examiner as the core structure of the final product of the claimed process excluding the variables; that the core structure of the final product does not define a contribution over the prior art; and see Hill et al., for example.

The Office Action stated there are two requirements that have to be met when considering unity of invention in relation to Markush practice as mentioned in applicants arguments on pages 13 and 14: 'When the Markush grouping is for alternatives of chemical compounds, they shall be regarded as being of a similar nature where the following criteria are fulfilled: (A) All alternatives have a common property or activity; and (B)(1) A common structure is present. i.e., a significant structural element is shared by all of the alternatives; or (B)(2) In case where the common structure cannot be the unifying criteria, all alternative belong to a recognized class of chemical compounds in the art to which the invention pertains".

The Office Action stated: that the Examiner agrees that part (A) has been fulfilled where there is a common property or activity but part (B) has not fulfilled; that the various final products of formula I being prepared according to Claim 1 are structurally different and classified

differently; that, for example, R<sup>1</sup> can be an alkyl group, phenyl ring, or thienyl ring; that the thienyl group is a heterocyclic ring and, therefore, controls the classification of the final product; that, the final product would be classified in 549 but when R<sup>1</sup> is alkyl then the final product might be classified in 564 depending on what group R<sup>2</sup> represents; that the Examiner further states that prior art found on Group I cannot necessarily be used as prior art against Group IV; that so, therefore, these groups are considered different inventions; that, however, the Examiner will combine Groups I and II since these two groups would be classified similarly; and that Groups III and IV will not be rejoined because these two groups are classified in different classes from Groups I and II whether you classify the groups according to a process of preparing (Class 514) or a final product (Class 549). Applicants thank the Examiner for combining Groups I and II for examination.

The Office Action stated that applicants also argue that the Examiner has not factually shown in the record that Wilkerson supports the Examiner's position when using the U.S. Patent No. 4,949,183 as a reference to show that applicants' invention has lack of unity; that the Examiner wants to point out that the reference is only being used to show what is in the prior art and that the applicants' special technical feature (i.e. the final product of formula I) does not provide a contribution over the art; and that, therefore it is not required to obtain support from the inventorship of the patent of the Examiner's position that the instant application has a lack of unity.

The Office Action stated that, therefore the lack of Unity between Groups I, III and IV indicated in the Restriction Requirement are maintained. Applicants still disagree with the Examiner on this matter.

The Office Action stated; that the Examiner has to search the claimed invention thoroughly and that includes searching the process as well as the final product; that, since the final products can be classified in various classes, different search considerations are involved (i.e., class/subclass searches, databases searches, etc.) for each of the groups listed; that the

inventions are classified into classes, for example, 514, 549 and 564; that, however, each Class 514, 549, and 564 encompasses numerous patents and published applications; that, for instance, Class 514 contained 165,171 patents and published applications; that, therefore it would constitute a burden on the Examiner and the Patent Office's resources to examine the instant application in its entirety.

The Office Action stated that subject matter not encompassed by elected Groups I and n are withdrawn from further consideration pursuant to 37 CFR 1.142 (b), as being drawn to nonelected inventions.

Claims 1 to 8, 21 to 25, 31 and 32 have been objected to as containing non-elected subject matter.

The Office Action stated that, to overcome this objection, applicants should submit an amendment deleting the non-elected subject matter. The non-elected subject matter has been removed.

This objection is now moot and its withdrawal is requested.

The Office Action stated that applicants are reminded of the proper language and format for an abstract of the disclosure:

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc,

The Abstract Of The Disclosure has been objected to because for exceeding 150 words.

The Office Action stated: that correction is required; and see MPEP § 608.01 (b).

The amended abstract is believed to be within the total word limitation.

This objection is now moot.

If the Examiner requires further amendment to restrict the claims to the elected inventions, please call the undersigned attorney at 202-659-2000.

Reconsideration, reexamination and allowance of the claims are requested.

Respectfully submitted,

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Date

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